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**DEC 01 2005**

**OFFICE OF PETITIONS**

In re Application of  
Paul R. Goldberg et al.  
Application No. 09/854,166  
Filed: May 11, 2001  
Attorney Docket No. QUSA.021US0

ON PETITION

This is a decision on the petition filed November 8, 2005, under 37 CFR 1.137(a)<sup>1</sup> and alternatively under 37 CFR 1.137(b)<sup>2</sup>, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **GRANTED**.

The petition under 37 CFR 1.137(b) is **DISMISSED** as involving moot issues.

This application became abandoned January 14, 2005 for failure to file a proper and

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<sup>1</sup> A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

<sup>2</sup> Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

timely response to the Restriction Requirement mailed December 13, 2004. Accordingly, a Notice of Abandonment was mailed June 30, 2005.

Petitioner argues that a change of address by way of a customer number change was filed for a number of patent applications, including the instant application, through the Electronic Business Center, but that the USPTO inadvertently re-entered the Power of Attorney filed September 7, 2001. Petitioner further argues therefore that the Restriction Requirement mailed December 13, 2004 was mailed to the old address and thus was not received. As proof that a request for an address change was submitted, petitioner submits a copy of the USPTO date-stamped post card receipt and correspondence mailed October 2, 2003 to the correct address to show that the address was in fact changed and then inadvertently changed back to the old address, all prior to the mailing of the Restriction Requirement mailed December 13, 2004.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.<sup>3</sup>

Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>4</sup>

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<sup>3</sup>In *re Mattullath*, 38 App. D.C. 497, 514-15 (1912)(quoting *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also *Winkler v. Ladd*, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172 (D.C. Cir. 1963); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>4</sup>*Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

A review of the file reveals that the petitioner is correct, that a change of address was in fact filed prior to the mailing of the Restriction Requirement and then inadvertently, by the USPTO, changed back to the old address. Further, the Restriction Requirement and the Notice of Abandonment were both returned to the USPTO by the United States Postal Service as undeliverable. It is noted therefore that an error on the part of the USPTO caused the office action mailed to not be received by the petitioner. Thus, petitioner's delay in responding to the Restriction Requirement was unavoidable under the standard set out at 37 CFR 1.137(a).

In view thereof, it will not be necessary to treat this petition alternatively under 37 CFR 1.137(b), the unintentional standard.

The address has been corrected and this matter is being referred to Technology Center 2654 for review of the response to the Restriction Requirement and for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style with a large initial "P".

Patricia Faison-Ball  
Senior Petitions Attorney  
Office of Petitions